

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Thomas GRAFENAUER

Group Art Unit: 3635

Appln. No. : 10/697,567

Examiner: Laux, Jessica L.

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For : FLOOR PANEL

REPLY BRIEF UNDER 37 C.F.R. 41.41(a)(1)

Commissioner for Patents
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Sir,

This Reply Brief is in response to the Examiner's Answer dated October 10, 2007, the period for reply extending until December 10, 2007. In the Examiner's Answer, the rejection of claims 1, 3-7, 9, 12, and 13 under 35 U.S.C. §102(b) as being anticipated by WO 01/75247 ("Palsson") is maintained.

Appellants note this Reply Brief is being filed under 37 C.F.R. §41.41(a)(1) and is directed to the arguments presented in the Examiner's Answer, and therefore must be entered unless the final rejection is withdrawn in response to the instant Reply Brief. With regard to this Reply Brief, Appellants note it is addressing points made in the Examiner's Answer and not repeating the arguments set forth in the Appeal Brief.

POINTS OF ARGUMENT

First Issue

The Examiner asserts that the status of the claims contained in the Appeal Brief filed August 14, 2007 (“Appeal Brief”) is incorrect. Appellants acknowledge that canceled claims 2, 8, 10, and 11 were inadvertently not recited in the status of the claims contained in the Appeal Brief. The Examiner’s status of the claims is correct.

Second Issue

The Examiner acknowledges Palsson’s two snapping hooks 23 (see FIG. 5 of Palsson) do not constitute the recited *form fitting elements for locking in the vertical direction with a further panel*, as recited in claim 1 (Examiner’s Answer, page 6). Appellants agree and note that Palsson’s snapping hooks 23 are not spaced apart from one another in the transverse direction on two spaced-apart essentially vertical walls, as additionally recited in claim 1. Instead, Palsson’s snapping hooks 23 are arranged on the same wall (i.e., are not on spaced apart vertical walls) and are aligned one over the other (i.e., are not spaced art in the transverse direction).

The Examiner, however, maintains the position that one of Palsson’s snapping hooks 23 and the lower cheek surface 21 constitute the form fitting elements for locking in the vertical direction with a further panel recited in claims 1 and 5. More specifically, the Examiner explains that the phrase “for locking in the vertical direction with a further panel” is being interpreted as meaning that the further panel to which the recited panel is connected is prevented from vertical movement (Examiner’s Answer, pages 6-7). The Examiner concludes that Palsson shows a right panel and a left panel in FIG. 5, that the right panel has features 21 and 23, and the feature 21 of the right panel provides a connection that prevents the left panel from moving upwards.

Applicants respectfully disagree, and submit that Examiner is incorrectly interpreting the claims. Representative claim 1 recites “a panel ... comprising form fitting elements for locking

in the vertical direction with a further panel.” The claimed invention recites that the panel having the form fitting elements is locked in the vertical direction. Put another way, the phrase “for locking in the vertical direction” modifies the panel having the form fitting elements, not the further panel. Thus, the recitation requires that the panel having the form fitting elements is what is locked in the vertical direction. Palsson’s feature 21 does not lock the panel of which it is part in the vertical direction.

Appellants acknowledge that, during patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification (see, e.g., MPEP §2111). However, Appellants submit that the Examiner’s interpretation of the term “form-fitting elements for locking in the vertical direction with a further panel” is not consistent with the specification or claims, as written, or the interpretation which would be given by one of ordinary skill in the art.

For example, the locking elements of the present invention are described as engaging undercuts on another panel for providing locking in the vertical direction. More specifically, Appellants’ specification states:

[0022] As can clearly be seen in FIG. 2, effective locking is provided both in the transverse direction Q and in the vertical direction V, the locking in the transverse direction Q being realized with form-fitting action by the shoulders 25, 250. Locking in the vertical direction V takes place by way of the locking elements 23, 24, which engage with form-fitting action in the undercuts 230, 240, the form-fitting elements 23, 24 being arranged on spaced-apart walls 21, 22.
[emphasis added].

Thus, the form-fitting elements 23, 24 of Appellants’ panel engage with undercuts of a further panel, thereby implying that it is upward movement of the recited panel that is prevented (not upward movement of the further panel, as asserted by the Examiner). Moreover, inspection of FIG. 3 in view of above-noted paragraph [0022] also reveals that form-fitting elements 23, 24

prevent upward movement of the recited panel. In fact, the form-fitting elements 23, 24 as described and shown in Appellants' invention do not operate in the manner suggested by the Examiner's interpretation (i.e., preventing the further panel from being moved upwardly).

Thus, the Examiner's interpretation of Palsson is directly opposite to that which is described and shown in Appellants' specification and figures, and recited in the claimed invention.

Based upon the above-noted description of form-fitting elements provided in Appellants' specification, and based upon the usage of the term in the claims, Appellants submit that Palsson's lower cheek surface 21 cannot reasonably be considered as one of the recited form-fitting elements for locking in the vertical direction with a further panel. As such, the rejection based upon Palsson is improper because the Examiner's interpretation of the claimed terms is inconsistent with the meaning consistently used by Appellants in the claimed invention and the specification. As the following passages of the MPEP make clear, the Examiner is not free to disregard the meaning given to a term in the specification simply for the purpose of conforming the applied art to a recited claim term:

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification.

(MPEP §2111) [emphasis added].

...

[T]he words of the claim must be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

(MPEP §2111.01) [emphasis added].

...

The ordinary and customary meaning of a term may be evidenced by a variety of sources, including "the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art." *Phillips v. AWH Corp.*, 415 F.3d at 1314, 75 USPQ2d at 1327.

(MPEP §2111.01) [emphasis added].

...

If extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant's use of the terms. *Brookhill-Wilk I*, 334 F. 3d at 1300, 67 USPQ2d at 1137; see also *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998) ("Where there are several common meanings for a claim term, the patent disclosure serves to point away from the improper meanings and toward the proper meanings.")

(MPEP §2111.01) [emphasis added].

Moreover, Appellants note that looking to the specification for the purpose of interpreting or defining a recited claim term is not an improper attempt to read limitations from the specification into the claims. More specifically, MPEP §2111 notes:

... reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)

Since the term "form-fitting elements" is explicitly recited in the claims, it is proper to look to the specification for guidance in interpreting this term. As such, when the term "form-fitting elements" is interpreted consistent with the specification and the other language in the claims, it is clear that Palsson's lower cheek surface 21 does not constitute such a form-fitting element.

For all of the above-discussed reasons, Appellants submit that the Examiner is improperly interpreting the recited term "form-fitting elements for locking in the vertical direction with a further panel." Since Palsson's lower cheek surface 21 does not constitute such a form fitting element, Palsson does not disclose all of the features of independent claims 1 and 5. Accordingly, the rejection is improper and should be reversed, and the application should be remanded to the Examining Group for allowance.

Third Issue

Appellants argued that Palsson does not disclose undercuts which correspond with the one and the other form-fitting elements, as recited in claim 4 (Appeal Brief, pages 9-11). More specifically, Appellants acknowledged that element 24 constitutes an undercut, but argued that Palsson's upper cheek surface 22 does not constitute an undercut as recited in the claimed invention.

The Examiner maintains the position that Palsson's upper cheek surface 22 constitutes an undercut. More specifically, the Examiner contends that if Palsson's panel were flipped (upside-down), then upper cheek surface 22 could be an undercut. The Examiner speculates that Palsson's panel may be flipped during manufacture to perform a cut that produces upper cheek surface 22, and then flipped back to the original orientation (Examiner's Answer, pages 8-9).

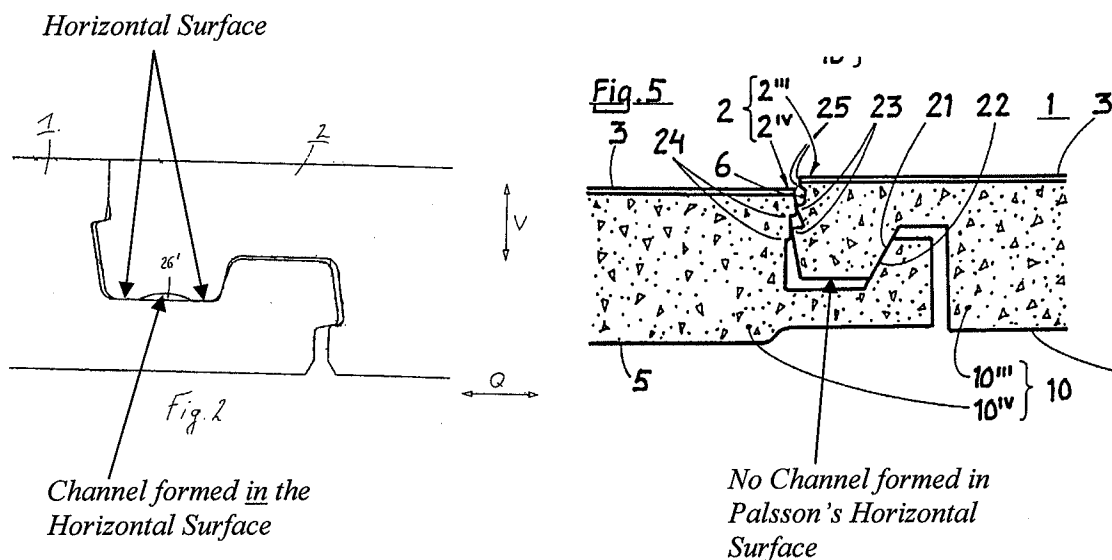
Appellants respectfully disagree with this interpretation of Palsson, and submit that it is not reasonable and is not consistent with Appellants' specification. Appellants undercuts 230, 240 are clearly shown formed on the underside of respective portions the panel (i.e., facing downward). Appellants' panel need not be flipped upside-down for elements 230, 240 to be considered undercuts.

Moreover, even if Palsson's panel were flipped upside-down such that upper cheek surface 22 were on an underside of the panel, this would result in Palsson's element 24 no longer being an undercut. That is, Palsson's elements 22 and 24 (i.e., what the Examiner identifies as the undercuts) are formed in opposite facing directions. When one is facing downward, the other is facing upward. As such, the Examiner's interpretation regarding upper cheek surface 22 necessarily negates element 24 from being an undercut. Therefore, Palsson does not disclose [plural] undercuts, as recited in the claimed invention. Accordingly, the rejection is improper and should be reversed, and the application should be remanded to the Examining Group.

Fourth Issue

Appellants argued that Palsson does not disclose the first step-like milled relief forms a shoulder which projects in a direction of the underside and has an essentially horizontally oriented head surface, and a channel formed in the head surface, as recited in claim 4 (Appeal Brief, page 11). More specifically, Appellants argued that what the Examiner identifies as a channel in Palsson is not comprised in an essentially horizontally oriented head surface of a shoulder which projects in a direction of the underside. A similar argument was made with respect to claim 5 (Appeal Brief, pages 14-15).

The Examiner maintains the position that the space between element 21 and the body of the panel in FIG. 5 of Palsson constitutes the recited channel. (Examiner's Answer, pages 9-10). Appellants respectfully disagree, and note that claim 4 recites "a channel formed in the head surface" and claim 5 recites "an essentially horizontal head surface with a channel formed therein." Palsson does not disclose a channel formed in such a horizontal surface. This is demonstrated by comparison of Appellants' FIG. 2 to Palsson's FIG. 5, reproduced with annotations below.



As is clearly seen in Appellants' FIG. 2, channel 26' is formed in (i.e., within the confines of) the horizontal surface. In contrast, Palsson shows a horizontal surface without any channel formed therein. What the Examiner identifies as a channel (i.e., the space between wall 21 and body 5 of the board) is not formed in a horizontal surface.

Therefore, Palsson does not disclose a channel formed in the horizontal head surface, as recited in claim 4, or an essentially horizontal head surface with a channel formed therein, as recited in claim 5. Accordingly, the rejection of these claims is improper and should be reversed, and the application should be remanded to the Examining Group for allowance.

Fifth Issue

Appellants argued that Palsson does not disclose the walls forming at least a portion of the tongue and groove, respectively, are sized and shaped to form a dust pocket, as recited in claim 12 (Appeal Brief, pages 10-11). A similar argument was made with respect to claim 12.

The Examiner maintains the position that Palsson inherently discloses this feature. More specifically, the Examiner contends that manufacturing processes would necessarily result in tolerances between Palsson's tongue and groove where a dust particle could get into. The Examiner also states that "it is possible to determine from the drawings to determine that the size and shape of the tongue and groove of Palsson are the same size and shape as those claimed and disclosed by appellant" (Examiner's Answer, pages 10-11).

Appellants respectfully disagree, and note that MPEP §2125 provides the following guidance with regard to using drawings as prior art:

Drawings and pictures can anticipate claims if they clearly show the structure which is claimed. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25 (CCPA 1972). However, the picture must show all the claimed structural features and how they are put together. *Jockmus v. Leviton*, 28 F.2d 812 (2d Cir. 1928).

...

When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurement of the drawing features are of

little value. See *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000) (The disclosure gave no indication that the drawings were drawn to scale. “[I]t is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.”).

Appellants respectfully submit that Palsson’s drawings do not clearly show the structure that is claimed. Unlike Appellants’ FIG. 1, Palsson does not show two panels in the assembled state; therefore, based upon the above-noted guidance of the MPEP, it is impossible to determine from the drawings whether the tongue and groove are shaped to form as dust pocket. Also, Palsson’s description is completely silent with regard to dust pockets. Therefore, the rejection is improper to the extent the Examiner is relying on Palsson’s drawings to disclose the recited dust pockets.

With regard to the Examiner’s assertion of inherency, Appellants note that the Examiner fails to provide any factual evidence the assertion that manufacturing processes will necessarily result in tolerances between Palsson’s tongue and groove where a dust particle could get into. The Examiner’s reasoning regarding manufacturing processes is unsupported speculation, and does not establish the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. For example, the Examiner provides no factual evidence regarding the alluded to sizes (i.e., dimensions) of tolerances in Palsson’s apparatus and dust particles. Without knowing the dimensions of dust particles and Palsson’s tolerances, the Examiner’s position is reduced to speculation of what “might be.” This is improper since inherency must be based upon characteristics that necessarily flow from the teachings of the art, and cannot be based upon on possibilities or probabilities. Therefore, the rejection is improper to the extent that it is based upon inherency.

Also, it is well known that panels should be locked tightly together (e.g., to prevent warping/swelling from moisture that can seep into loose joints). Therefore, it is plausible that Palsson's panels are manufactured to a very tight tolerance. Without any disclosure of the dimensions and tolerances of Palsson's panels, it is simply not possible to say that a dust chamber would inherently result from the manufacturing process.

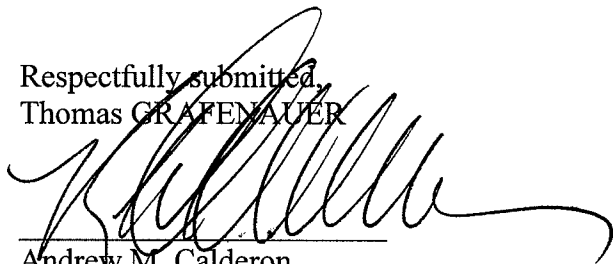
Accordingly, the rejection of claims 12 and 13 is improper and should be reversed, and the application should be remanded to the Examining Group for allowance.

CONCLUSION

For the reasons expressed above, Appellants respectfully request that the grounds of rejection advanced by the Examiner be reversed. Appellants further request that the application be returned to the Examining Group for prompt allowance.

The undersigned authorizes the charging of any necessary fees, including any extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, to Deposit Account No. 19 - 0089 in order to maintain pendency of this application.

Respectfully submitted,
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